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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,856	06/26/2003	Jerry M. Roane	067140.0104	5847

31625 7590 09/22/2004

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EXAMINER


LE, MARK T

ART UNIT PAPER NUMBER

3617

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/606,856	Applicant(s) ROANE, JERRY M.	
	Examiner Mark T. Le	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This communication is responsive to the amendments filed on July 23, 2004.

Applicant's amendments and remarks have been carefully considered.

2. Applicant's responses, filed on July 23, 2004, have not satisfied the drawing requirements under 37 CFR 1.83(a). Claimed structures must be shown in the drawings or they must be cancelled from the claims. The objection is repeated below.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rail adjustment actuator, as recited in claim 10; the rails being aligned in different planes, as recited in instant claim 12; and the circular grid, as recited in instant claims 13, must be shown or the features must be canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 10, 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 54-70505 in view of Li (US 5,797,330).

The Japanese reference discloses a rail system, similar to that recited in the instant claims, including a plurality of non-interconnected rails 5-8 (Figs. 1-2) supported by a plurality of supports with rail adjustment actuators (Figs. 5-6).

Regarding the rail being a triangular shell as recited in instant claim 10, consider rail 22 in the form of a triangular shell of Li. In view Li, it would have been obvious to one skilled in the art to form the rails of the Japanese reference in a configuration similar to that of Li so as to accommodate the vehicles similar to that of Li.

Regarding the rail being extruded, as recited in instant claim 10, note that hollow beams or structural members formed by extrusions are well known (Official Notice is taken). Accordingly, it would have been obvious to one skilled in the art to form the hollow rail structural members of the Japanese reference, as modified, by the well known method of extrusions so as to achieve expected advantages thereof, such as in terms of greater efficiency, and enhanced cross-sectional uniformity and consistency.

As to the instant claimed intended use, recited in instant claim 10, note that the rail configuration of the Japanese reference, as modified, is inherently capable of the instant claimed intended use with rail and roadway vehicles that have compatible features for operation on said rail configuration.

Regarding the rails being in different planes, recited in instant claim 12, consider Figs. 1 and 2 of the Japanese reference; wherein, the rails are at least in different vertical planes.

Regarding the instant claimed entry and exit points of each rail, as recited in instant claims 14-15, note that each rails 5-8 of the Japanese reference includes entry and exit points, which are inherently capable being placed in the intended uses as broadly recited in the last two lines of claim 14, and in the last five lines of claim 15.

4. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 10 above, and further in view of Renaux (US 4,018,410).

Regarding the interconnected rails being disposed along a perpendicular or circular grid, as recited in claim 11 or 13, it is noted that the Japanese reference does not disclose a complete track layout. On the other hand, Renaux discloses various track layouts; wherein, Figure 1 shows perpendicular grids, and Figure 2 shows perpendicular and circular grids. In view of Renaux, it would have been obvious to one skilled in the art to provide track layouts, similar to that of Renaux, for operating with the track switch arrangement of the Japanese reference so as to achieve expected advantages of Renaux's track layout, such greater flexibilities in serving a highly populated area.

5. Responses to Applicant's Arguments:

In response to Applicant's argument that there is no suggestion from the applied prior art that the prior art rail system is made "for transporting dual use vehicles", note

that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding to Applicant's argument that the prior art structure does not disclose "non-interconnected rails", note that the set of rails 1, 5, 7, 3 of Japanese reference '505 is not in connection with the set of rails 2, 6, 8, 4 when the two rail lines of the respective sets of rails in the straight positions as shown in the solid lines of Figures 1 and 2 of the Japanese reference; on the other hand, note that rails 1-8 of the Japanese reference are not connected to each other as shown with the gaps between adjacent rails for allowing relative movements between the adjacent rails.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

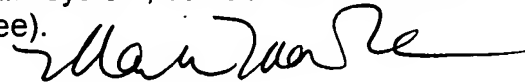
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 703-308-3663. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark T. Le
Primary Examiner
Art Unit 3617

mle
9/17/04